

REMARKS

In section 2, Claim 33 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Examiner alleges that claim 33 must be a computer program stored in a computer-readable medium, wherein the computer-readable medium is not defined as a signal or transmittal wave, etc., in the specification. (i.e. the claimed invention cannot be a software program without being stored on a form of medium, e.g. disk). The Applicant respectfully disagrees with the Examiner. The Applicant is not familiar with a statute which requires that the claim has to be "a computer program stored in a computer-readable medium" vs. "a computer program product" and requests the Examiner to provide such a statute to validate the Examiner's objection.

Furthermore, claim 33 of the present invention recites "a computer readable storage structure embodying computer program code ..." which implies that the computer program is stored in the computer-readable medium. MPEP section 2106.1 (a) states:

" In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory."

Therefore, claim 33 of the present invention describes a statutory subject matter.

In Section 3, Claims 1-18 and 23-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner alleges that the language in the following claims is not clearly understood:

As per claim 1, lines 11-14, it is unclear how an access request signal can be forwarded by a terminal when the access request signal is already sent by the terminal in lines 7-10.

As per claim 23, line 15, it is unclear if the network actually comprises an authentication block (i.e. "optionally" is indefinite).

The Applicant respectively disagrees with the Examiner.

Regarding independent claim 1, lines 11-14, the term "forwarding" recited in claim 1 is apparent from the specification (e.g., see page 17, lines 8-14, Figures 1 and 2 wherein the signal 30 or 30a are forwarded by the terminal 10 as shown by dotted lines). Thus, as recited in claim 1, the terminal 10 first sends an access-request signal (30, 30a) to the network 16 (e.g., to the trusted location register 18) and then the terminal 10 forwards the signal 30 or 30a sequentially, e.g., as explained in the specification on page 17, lines 8-14 and on page 18, lines 2-6:

"After the trusted APN 20 is identified to the terminal 10, the terminal 10 forwards the request (access-request signal 30) to the trusted APN 20, which identifies a trusted domain name service (DNS) server 22 of the network 16. The terminal 10 gets the address of the trusted DNS server 22 from the trusted APN 20 and forwards the request (access-request signal 30) to the trusted DNS

server 22 to identify address mapping for the help-portal server (e.g., WEB server) 24 of the network 16 based on the URL allowed by the access control profile of the terminal 10."... "The propagation of the access-request signal 30 from the HLR 18 through the APN 20 and further through the DNS 22 to the help-portal server 24 is shown by arrows with dotted lines to demonstrate a logical flow of information whereas the actual procedure involves a continuous exchange of the information with the terminal 10 as described above."

MPEP fully supports the above arguments. For example, in MPEP section 608.01(0) it is stated:

"The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import;... A term used in the claims may be given a special meaning in the description."

Moreover, in MPEP section 2173.01 it is further stated:

"A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as **>any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01.< Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected

solely because of the type of language used to define the subject matter for which patent protection is sought."

The arguments presented above are also applied to claims 2-18 and 23-29. Thus, claims 2-18 and 23-29 are distinctly claim the subject matter which Applicant regards as the invention contrary to the arguments presented by the Examiner and indefiniteness rejection under 35 U.S.C. 112, second paragraph, is shown to be inapplicable.

Regarding claim 23, line 15, the applicant disagrees that the use of "optionally" is indefinite. The MPEP Section 2173.05(h).III states:

"An alternative format which requires some analysis before concluding whether or not the language is indefinite involves the use of the term "optionally." In *Ex parte Cordova*, 10 USPQ2d 1949 (Bd.Pat. App. & Inter. 1989) the language 'containing A, B, and optionally C' was considered acceptable alternative language because there was no ambiguity as to which alternatives are covered by the claim. A similar holding was reached with regard to the term "optionally" in *Ex parte Wu*, 10 USPQ2d 2031 (Bd. Pat. App. & Inter. 1989). In the instance where the list of potential alternatives can vary and ambiguity arises, then it is proper to make a rejection under 35 U.S.C. 112, second paragraph, and explain why there is confusion."

Claim 23 of the present invention clearly states without any ambiguity that the cellular communication system (11) can optionally comprise an authentication block (26). Therefore claim 23 distinctly claims the subject matter which applicant regards as the invention contrary to the arguments presented by the Examiner and indefiniteness

rejection under 35 U.S.C. 112, second paragraph, is shown to be inapplicable.

In Section 5, Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalke, U.S. Patent Application Publication 2004/0137890 (hereinafter Kalke) in view of Martin, Jr. et al., U.S. Patent Application Publication 2003/0023849 (hereinafter Martin et al.) The Applicant believes that the Examiner's statements are not accurate and need further clarification.

The 35 U.S.C.103(a) rejection of claims 1-34 is analyzed using MPEP guidelines which are stated in the MPEP Paragraph 2143 as follows:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Regarding claim 1, first, Kalke in view of Martin et al. do not teach or suggest all the limitations of independent claim 1 as required by the MPEP Paragraph 2143 to establish a *prima facie* case of obviousness.

For example, the limitation of claim 1 stating that the network 16 is provided by the service provider is not taught by Kalke or by Martin et al.

Moreover, none of the references quoted by the Examiner teach that a **well-known (generic) uniform resource locator (URL)** was used for forwarding (52, 52a) the access-request signal (30, 30a) to the help-portal server (24, 24a) by the terminal (10), as recited in claim 1 of the present invention. In paragraph 106, Kalke mentions as one of the firewall rules: " configure the portal to support (e.g., via URL steering) a non-provisioned subscriber,...". The Applicant does not clearly understand the Kalke's teaching quoted above (is he teaching here configuring the portal?), but thinks that the URL steering mentioned by Kalke is different from providing the well-known (or generic) URL of the help-portal server 24 used by the terminal 10 recited in claim 1 of the present invention and supported by the specification. Later in regard to claims 10 and 24, the Examiner again discussed the URL and alleged that it is inherent that DNS query must include a URL in order for the DNS to retrieve a list of IP addresses. Even if the Examiner is correct, paragraph 86 of Kalke recites the IP address of the GGSN and not the IP address of the help-portal server 24 as in the present invention (see page 17, lines 30-31). Thus the URL briefly mentioned by Kalke is different from the **well-known (generic) uniform resource locator (URL)** recited in claim 1 of the present invention.

Furthermore, none of the references quoted by the Examiner teach about providing a chain of trust recited in claim 1. Martin et al. only describes coupling trust from a primary provisional domain (TPD) to a secondary TPD. Martin

et al. does not teach providing the trust from the secondary TPD to a further secondary TPD which is recited in claim 1 by using the term "chain" which implies propagating the trust sequentially from one network element to another multiple times as fully supported by the specification of the present invention. In other words, if it is only one transmission of trust from one element to another, as taught by Martin et al., it is not the same as establishing a chain of trust involving multiple "handover" of trust from element to element as recited in claim 1 and supported by the specification of the present invention.

The Applicant notes that the Examiner, while rejecting claim 1, quotes many paragraphs from different examples of Kalke (e.g., examples 6, 10, 11, 14, 17, 27, etc.), wherein most of these examples are independent and are not formerly related to each other (this is evident by the fact that almost all elements have different numbers in different figures related to the appropriate examples). Thus, the Examiner also has a burden of proof to demonstrate motivation and desirability of combining the features taught by Kalke in those multiple independent examples to describe the limitations of claim 1 of the present invention, i.e., to prove that a person skilled in the art can combine all features mentioned in these multiple examples of Kalke without the benefit of hindsight to establish a *prima facie* case of obviousness.

Second, even if only for the sake of argument we assume that Kalke in view of Martin et al. teach or suggest all the limitations of the independent claim 1, there is no suggested desirability or motivation, expressed explicitly, implicitly or even hinted at by either Kalke, Martin et al.

or generally available to one of ordinary skill in the art (as required by the MPEP Paragraph 2143 referenced above and by the case law) to modify the references or to combine reference teachings to arrive at the subject matter of claim 1 of the present invention.

In other words, the Examiner failed to show a *prima facie* case of obviousness because he does not show any basis present in the art at the time of the invention for combining or modifying references. The Federal Circuit Court has several times expressly addressed the issue.

For example, *in re Geiger, supra*, it is stated, in holding that the USPTO "failed to establish a *prima facie* case of obviousness":

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)."

Furthermore, Judge Newman, in her opinion in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed Cir. 2002), repeats this fundamental principle:

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

Therefore, it is highly unlikely that somebody of ordinary skill in the art would have been reasonably expected to combine references (teaching different

components of claim 1) quoted by the Examiner at the time of the invention and to find the solution claimed by the Applicant without the benefit of hindsight (also as required by the MPEP paragraph 2143 referenced above and by the case law). Moreover, Kalke and Martin et al. do not provide teaching or suggestion for the reasonable expectation of success by combining their teaching, as required by the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

The arguments presented above in regard to claim 1 are fully applied to independent claim 19.

Regarding claims 2-18, 20-34, these are dependent (directly or indirectly) claims of independent claims 1 and 19. Independent claims 1 and 19 are not unpatentable over Kalke in view of Martin et al., as shown above. Since each of the dependent claims 2-18, 20-34 narrows the scope of the corresponding novel and non-obvious independent claim 1 or 19, non-obviousness of claims 1 and 19 will compel non-obviousness of claims 2-18, 20-34.

Additional considerations regarding novelty of the dependent claims 2-18, 20-34 can be further provided if necessary considering additional limitations introduced in the dependent claims 2-18, 20-34. Below, the Applicant mentions a few examples of Examiner's inconsistencies in regards to rejections of dependent claims.

For example, regarding claim 3, the Examiner alleges that the browser system 222 of Kalke is the same as browser user agent block 12 of the terminal 10 in claim 3 of the present invention. It is obvious that the browser system 222 of Kalke is not a part of the terminal (mobile wireless

device 122) as shown in figure 3 of Kalke, therefore the Examiner's arguments are not applicable.

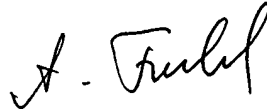
Moreover, regarding claim 11, Kalke describes selecting a login name, password, etc. by the subscriber, whereas claim 1 talks about authenticating the user by sending signals **34a** and **34b** and possibly using authentication block 26. These features are not taught by Kalke.

Furthermore, regarding claims 15 and 29, none of the references quoted by the Examiner describe sending two signals: initial provisioning triggering signal 27 and a further triggering signal 33. The Examiner alleges that two different signals send in Kalke and Martin et al. correspond to two signals 27 and 33 of the present invention again without any reasoning contained in those references or generally known in the art for the combining not only these two references but also adding a password in the triggering signal 33. Thus, the Examiner failed again to show a prima facie case of obviousness because he does not show any basis present in the art at the time of the invention for combining or modifying references.

Thus based on the above remarks, claims 1-34 are not obvious under 35 U.S.C. 103(a) as being unpatentable over Kalke in view of Martin et al.

The objections and rejections of the Office Action of September 20, 2005 having been obviated or shown to be inapplicable, withdrawal thereof is requested and passage of claims to issue is solicited.

Respectfully submitted,



Anatoly Frenkel
Attorney for the Applicant
Registration No. 31,391

AF/mef

Date: 11/21/05

WARE, FRESSOLA, VAN DER SLUYS

& ADOLPHSON LLP

755 Main Street, P.O. Box 224

Monroe, Connecticut 06468

(203) 261-1234